

REMARKS

Claims 1, 4, 6-10, 13, 15-21 and 23-26 are pending in this application. By this Amendment, claims 1 and 10 are amended and claims 2, 3, 11, and 12 are canceled. Reconsideration of the present application based on the above amendments and the following remarks is respectfully requested.

I. The Claims Define Allowable Subject Matter

Claims 1-4, 6-13, 15-21 and 23-26 are rejected under 35 U.S.C. §103(a) as unpatentable over U.S. Patent No. 5,546,191 to Hibi et al. in view of U.S. Patent No. 4,963,995 to Lang. This rejection is respectfully traversed.

None of the applied art teaches, discloses or suggests a playback system for replaying a first indexed recording that allows simultaneous recording of the activity while replaying the first indexed recording, and a recording system that records the activity and allows previously indexed recording to be re-recorded and inserted in a current second indexed recording, as claimed in claim 1 and similarly claimed in claim 10.

The Examiner admits that Hibi does not disclose the features discussed above. However, the Examiner asserts that Lang discloses these features. Applicants respectfully disagree.

Lang discloses that the DCU 14 can be used to edit and rearrange video segments. Additionally, a program may be edited one frame at a time by changing contrast, brightness, sharpness and colors. Further, a user interface control panel of the DCU 14 allows a user to select a desired frame number from a menu on the display. The user can delete frames in a strip and also select points where other frames are to be inserted into the program or enhance different frames. Accordingly, the features of the claimed invention are not taught or suggested in the applied art.

Additionally, Applicants respectfully submit that only the present application suggests the claimed combination of features. As such, the asserted combination of Hibi and Lang was made using improper hindsight reconstruction of the references.

It is well settled that a rejection based on 35 U.S.C. §103(a) must rest on a factual basis, which the Patent and Trademark Office has the initial duty of supplying. In re GPAC, Inc., 57 F.3d 1573, 1582, 35 USPQ2d 1116, 1123 (Fed. Cir. 1995). A showing of a suggestion, teaching, or motivation to combine the prior art references is an “essential evidentiary component of an obviousness holding.” *C.R. Bard, Inc. v. M3 Sys. Inc.*, 157 F.3d 1340, 1352, 48 USPQ2d 1225, 1232 (Fed. Cir. 1998). This evidence may flow from the prior art references themselves, the knowledge of one of ordinary skill in the art, or, in some cases, from the nature of the problem to be solved. See *Pro-Mold & Tool Co. v. Great Lakes Plastics, Inc.*, 75 F.3d 1568, 1573, 37 USPQ2d 1626, 1630 (Fed. Cir. 1996). However, the suggestion more often comes from the teachings of the pertinent references. See *In re Rouffet*, 149 F.3d 1350, 1359, 47 USPQ2d 1453, 1459 (Fed. Cir. 1998). This showing must be clear and particular, and broad statements drawing conclusions about the teaching of multiple references, standing alone, are not “evidence.” See *In re Dembiczak*, 175 F.3d 994 at 1000, 50 USPQ2d 1614 at 1617. However, the suggestion to combine need not be express and “may come from the prior art, as filtered through the knowledge of one skilled in the art.” *Motorola, Inc. v. Interdigital Tech. Corp.*, 121 F.3d 1461, 1472, 43 USPQ2d 1481, 1489 (Fed. Cir. 1997).

It is impermissible for an Examiner to engage in hindsight reconstruction of the prior art using Applicant's claims as a template and selecting elements from references to fill the page. The references themselves must provide some teaching whereby the claimed combination would have been obvious. *In re Gorman*, 911 F.2d 982, 986, 18 USPQ2d 1885,

1888 (Fed. Cir, 1991) (emphasis added). That is, something in the prior art as a whole must suggest the desirability, and thus obviousness, of making the combination. See, *In re Beattie*, 974 F.2d 1309, 1312, 24 USPQ2d 1040, 1042 (Fed. Cir. 1992); *Lindemann Maschinenfabrik GMBH v. American Hoist and Derrick Co.*, 730 F.2d 1452, 1462, 221 USPQ 481, 488 (Fed. Cir. 1984). He or she may not, because he or she doubts that the invention is patentable, resort to speculation, unfounded assumptions or hindsight reconstruction to supply deficiencies in the factual basis. See, *In re Warner*, 379 F.2d 1011, 1017, 154 USPQ 173, 178 (CCPA 1967), cert. denied, 389 U.S. 1057 (1968).

If the PTO fails to meet this burden, then the applicant is entitled to a patent. *In re Glaug*, 62 USPQ2d 1151 (Fed. Cir. 2002).

The Examiner has failed to meet this burden. As discussed above, a rejection under 35 U.S.C. §103(a) must be based on a facts and include a showing of a suggestion, teaching or *motivation* to combine the prior art references. The Office Action on page 4 asserts that it would have been obvious to one of ordinary skill in the art to modify Hibi with Lang by using incorporating editing means and recording/reproducing means as taught by Lang in the apparatus of Hibi thereby enhancing the capacity of the apparatus of Hibi for viewing and editing the video/audio information. This allegation is a prime example of impermissible hindsight reasoning.

Accordingly, withdrawal of the rejection of the claims under 35 U.S.C. §103(a) is respectfully requested.

II. Conclusion

In view of the foregoing, it is respectfully submitted that this application is in condition for allowance. Favorable reconsideration and prompt allowance of claims are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in even better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number listed below.

Respectfully submitted,



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